



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/549,682

01/17/2006

Alexander Schroeck

26994U

1169

20529 7590 11/17/2009
THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314

EXAMINER

RIPA, BRYAN D

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

11/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,682	Applicant(s) SCHROECK ET AL.	
	Examiner BRYAN D. RIPA	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/19/05; 4/7/06; 8/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-11 in the reply filed on October 6, 2009 is acknowledged.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement filed on September 19, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, patent F.R. 1,226,638 has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

1. Claims 6, 7 and 9 are objected to because of the following informalities. Specifically, claims 6, 7 and 9 each require a part of the connecting means to be “assigned to” another part. However, the use of the phrase “assigned to” is somewhat ambiguous and unclear since the phrase does not appear readily susceptible to a consistent interpretation amongst the claims. For instance, in claim 6 the phrase appears to require the part to be electrically connected to the current/voltage source. However, in claim 7 the phrase appears to denote the part being contained in a head or cover part. As a result, it is the examiner’s suggestion that the applicant amend the claims so as to clarify the relationship denoted by the phrase “assigned to”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claim 1 contains the phrase “in particular” which renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Art Unit: 1795

Also, claims 6 and 7 each contain the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

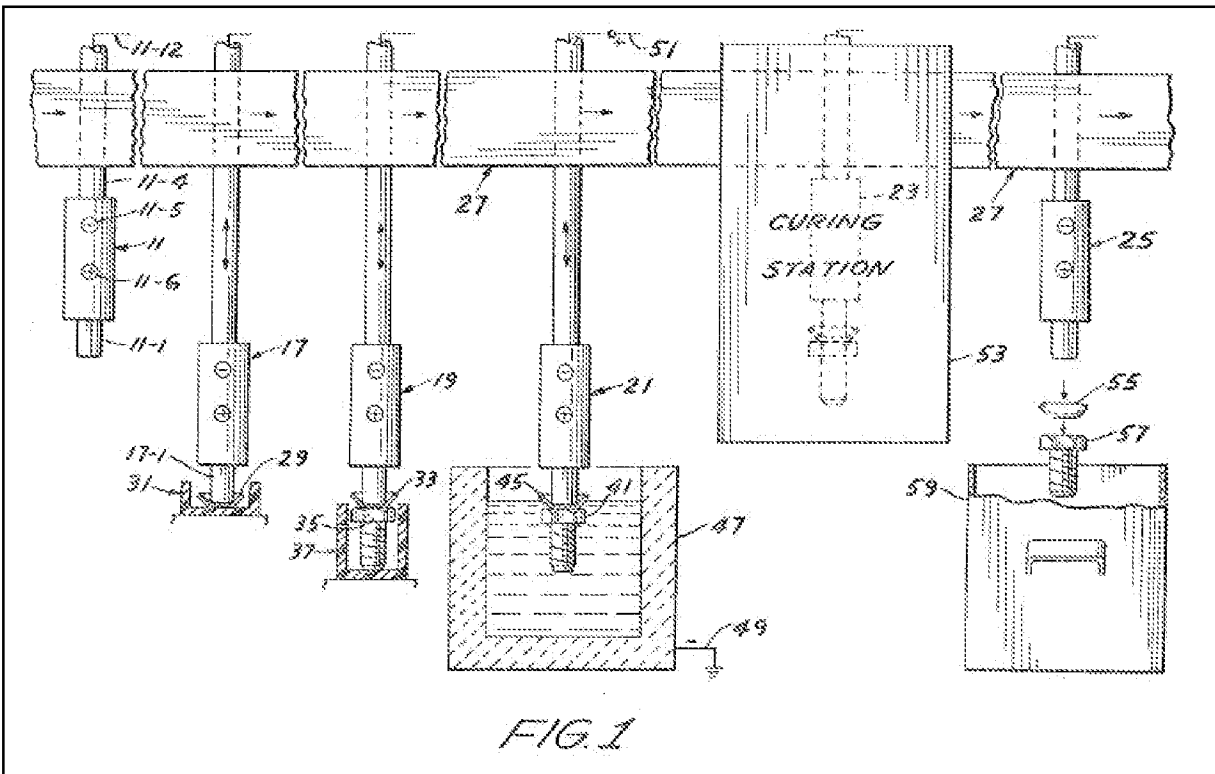
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (U.S. Pat. No. 3,575,832) (hereinafter referred to as "JOHNSON").

Regarding claim 1, JOHNSON teaches an apparatus for electrodeposition which is capable of functioning for the electrodeposition of shaped dental parts such as skeletons for crowns, inlays, bridges and the like (see generally col. 1 lines 20-22 teaching the apparatus for the electrodeposition of small objects) having at least one current/voltage source and electrodes which can be arranged in a vessel that can be filled with an electrolyte (see col. 3 lines 34-36 teaching the workpiece being electrically connected to a power source that acts as an electrode; see also col. 3 lines 29-34 teaching tank 47 being filled with a coating bath, i.e. an electrolyte), wherein there is at least one magnetic connecting means for producing the electrical contact for the

Art Unit: 1795

electrodeposition between at least one electrode and the current/voltage source (see col. 1 lines 49-58 teaching the assembly 21 comprising an electromagnet acting as a magnetic connecting means through which electrical contact is made to the workpiece).
See figure 1 below.



Please note, the phrase reciting the electrodeposition apparatus "in particular" for the electrodeposition of various dental parts as merely reciting an example of the article or workpiece which is to be plated.

Regarding claim 2, JOHNSON teaches the apparatus for electrodeposition wherein the magnetic connecting means comprises two parts which interact with one another through magnetic force (see assembly 21 and workpiece 41 comprising two parts which interact with one another through magnetic force). See figure 1 above.

Regarding claim 4, JOHNSON teaches the apparatus for electrodeposition wherein the magnetic connecting means comprises a magnet and magnetizable metal part (see assembly 21 and bolt 41 above comprising an electromagnet, i.e. a magnet, and a magnetizable metal part). See figure 1 above.

Regarding claim 5, JOHNSON teaches the apparatus for electrodeposition wherein the magnet has a round cross-sectional area (see core 17-1 comprising the contact of the electromagnet and having a round cross-sectional area). See figure 1 above.

Regarding claim 6, JOHNSON teaches the apparatus for electrodeposition wherein one of the parts of the magnetic connecting means, in particular a magnet, is assigned to the current/voltage source (see assembly 21 electrically connected to conduct 51 which is connected to the power source; see also col. 3 lines 34-36). See figure 1 above.

Please note, the examiner is interpreting the phrase “assigned to” as requiring the part to be electrically connected to the current/voltage source. The examiner

Art Unit: 1795

believes this interpretation to be the most in keeping with the disclosure and applicant's intent.

Additionally, the examiner is treating the limitation stating "in particular" as merely reciting an example of the part which is to be assigned to the current/voltage source and not as requiring the magnet to be assigned to the current/voltage source.

Regarding claim 7, JOHNSON teaches the apparatus for electrodeposition wherein the part, in particular the magnet, is assigned to a head or cover part which during electrodeposition is located above the vessel that can be filled with the electrolyte and at which the electrodes are preferably also arranged (see assembly 21 comprising a head or cover part which is located above tank 47). See figure 1 above.

Please note, the examiner is interpreting the phrase "assigned to" in claim 7 as requiring the part to be contained within the head or cover part. The examiner believes this interpretation to be the most in keeping with the disclosure and applicant's intent.

Additionally, as mentioned above, the examiner is treating the limitation stating "in particular" as merely reciting an example of the part which is to be assigned to the head or cover part and not as requiring the magnet to be assigned to the head or cover part.

Regarding claim 8, JOHNSON teaches the apparatus for electrodeposition wherein the magnet is arranged in a sleeve-like component (see thimble 45 acting as a

Art Unit: 1795

sleeve like component that is arranged around the electromagnet connecting core).

See figure 1 above.

Regarding claim 9, JOHNSON teaches the apparatus for electrodeposition wherein one part of the magnetic connecting means is assigned to an electrode or part of an electrode (see assembly 21 and col. 3 lines 34-36 teaching bolt 41, i.e. the workpiece, connected to the power supply through assembly 21 so as to act as an electrode during the electrodeposition). See figure 1 above.

Please note, the examiner is interpreting the phrase “assigned to” as requiring the magnetic connecting means to be electrically connected to an electrode or part of an electrode. The examiner believes this interpretation to be the most in keeping with the disclosure and applicant’s intent.

Regarding claim 10, JOHNSON teaches the apparatus for electrodeposition wherein the electrode or the electrode part is of a rod-like design (see assembly 21). See figure 1 above.

Regarding claim 11, JOHNSON teaches the apparatus for electrodeposition wherein the magnet is arranged in a sleeve-like receptacle in the electrode or in the electrode part (see thimble 45 acting as a sleeve like component that is arranged around the electromagnet connecting core in assembly 21). See figure 1 above.

Art Unit: 1795

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JOHNSON as applied to claims 1 and 2 above.

Regarding claim 3, JOHNSON does not explicitly teach the apparatus for electrodeposition wherein the magnetic connecting means comprises two magnets.

However, it would have been obvious to one of ordinary skill that with more complex workpieces, i.e. having more intricate structures, the addition of a second magnetic contact point or a second electromagnet might be required. In fact, the need to apply several contact points was considered by JOHNSON (see col. 4 lines 12-16

Art Unit: 1795

teaching the need to tailor the number of contact points depending upon the application).

Furthermore, the mere duplication of parts, without any new or unexpected results, is within the ambit of one of ordinary skill in the art. See *In re Harza*, 124 USPQ 378 (CCPA 1960) (see MPEP § 2144.04).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add an additional magnetic contact point depending on the shape and weight of the workpiece so as to have two magnets as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN D. RIPA whose telephone number is 571-270-7875. The examiner can normally be reached on Monday to Friday, 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, Art Unit 1795

/B. D. R./
Examiner, Art Unit 1795